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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/573,931

08/15/2006

Rocco Fortte

3724.1010-000

5385

21005

7590

09/18/2009

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EXAMINER

AULAKH, CHARANJIT

ART UNIT

PAPER NUMBER

1625

MAIL DATE

DELIVERY MODE

09/18/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/573,931	<b>Applicant(s)</b> FORTTE ET AL.	
	<b>Examiner</b> Charanjit S. Aulakh	<b>Art Unit</b> 1625	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 September 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 23-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/28/06</u>   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. According to paper filed on Sep. 3, 2009, the applicants have elected group I with traverse for further prosecution.

### ***Response to Arguments***

2. Applicant's arguments filed on Sep. 3, 2009 have been fully considered but they are not persuasive. The examiner does not agree with the applicants arguments that optional bond between atom D and a transition metal atom is the special technical feature of the instant compounds. First of all, as admitted by the applicants, .this bond is optional and is neither this bond nor metal is present in compounds of formula (4). Secondly, as stated clearly in the last office action, the inventions of different groups do not relate to a single inventive concept since there is no common core which in the Markush Practice, is a significant structural element shared by all of the alternatives. In the instant case, the variables D, D', Cy2, Cy3, Cy1, E, Y and Y' are critical for the common core of the instant compounds. Thus, restriction requirement as indicated is proper and thereby made final.

In regard to compound of example 88, these compounds will represent group VIII, directed to compounds of formulae (2) or (4) where both E and Y represent C, Cy3 and CY2 rings are 6-membered monocyclic aryl rings and CY1 ring is 6-membered heteroaryl ring containing only i nitrogen atom where D or D' represent N atom ( see

Art Unit: 1625

example 88 ), a process for preparing these compounds and methods of using these compounds.

3. Claims 23-43 are pending in the application.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 23-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In independent claims 23, 33 and 36, the value of variable R2 is not defined.

In claim 41, the term --- characterized in that --- is vague. The applicants are suggested to use the term --- wherein ---.

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 33-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Fabre ( U.S. Patent 4,128,650, cited on applicant's form 1449 ).

Fabre discloses Dibenzo[de,h]quinoline derivatives. The compound of formula II ( see col. 1, lines 40-50 ) where x represents H which is used as starting material ( see examples 2 and 4 ) anticipated the instant claims when variable Y' represents CR2 ( C=O ) group in the instant compounds of formula (4).

7. Claims 23-43 are objected for containing non-elected subject matter.

Art Unit: 1625

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charanjit S. Aulakh whose telephone number is (571)272-0678. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on (571)272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Charanjit S. Aulakh/  
Primary Examiner, Art Unit 1625